

REMARKS/ARGUMENTS

By this Amendment, claims 32-35, 37-39, and 75-76 are amended, claim 77 is cancelled, and claim 78 is added. Thus, claims 32-39, 75-76, and 78 are pending. An RCE is being filed concurrently herewith.

Rejection Under 35 U.S.C. §101

Claims 32-39 and 75-76 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. This rejection is respectfully traversed for at least the following reasons.

First, with respect to method claims 32-39, Applicant respectfully notes that the Supreme Court recently decided *In re Bilski* and made clear that the so-called “machine-or-transformation test” is not the exclusive test for patentability, insofar as “The Court is unaware of any ‘ordinary, contemporary, common meaning,’ . . . of the definitional terms ‘process, art or method’ that would require these terms to be tied to a machine or to transform an article.” *In re Bilski*, 561 U.S. __ (2010) (Slip op. at 7). According to the Supreme Court, the Federal Circuit “incorrectly concluded that [the Supreme Court] has endorsed the machine-or-transformation test as the exclusive test.” *Id.* Thus, Applicant respectfully submits that the basis for rejecting these claims is flawed.

Claim 32 in any event plainly is in fact tied to “a license ownership computer,” as evident from the preamble. This specific machine is further mentioned in the body of the claim in a step that plainly is not “mere extra-solution activity.”

[The Supreme] Court’s precedents establish that the machine-or-transformation test is a useful and important clue, an investigative tool, for determining whether some claimed inventions are processes under §101.

Id. (Slip op. at 8). Claim 32 and its dependents therefore satisfy the machine-or-transformation test, thereby providing “a useful and important clue” indicative of the patent-eligible subject matter recited therein and further suggesting that the rejection of these claims is flawed.

There is no detailed rejection of claim 75, which in any event is directed to a “license ownership computer system.” The rejection of this system claim plainly is inappropriate because it is directed to a system and not a method.

Claim 76 is directed to “non-transitory computer readable media including: software for effecting the method of claim 32.” Claim 76 therefore is directed to the media that stores the software and not “software per se.” This formulation is appropriate statutory subject matter as explained in the USPTO’s 1/26/2010 Memo entitled “Subject Matter Eligibility of Computer Readable Media.” Thus, applicant respectfully requests that this rejection be withdrawn.

Claim 77 is cancelled without prejudice or disclaimer, thereby mooting the § 101 rejection thereof.

In view of the foregoing, reconsideration and withdrawal of the § 101 rejection are respectfully requested.

Rejections under 35 U.S.C. § 112

Claims 32-39 and 75-76 stand rejected under 35 U.S.C. § 112, for various different reasons that appear to relate to both the first and second paragraphs of this Section. The Examiner is kindly requested to spell out the specific statutory provisions being relied upon in the next Action in the event that any of these rejections are maintained. In any event, these § 112 rejections are respectfully traversed for at least the following reasons.

First, with respect to claims 32 and 75, the Final Office Action states that these claims are “indefinite since the boundary of the claim[s] [are] ambiguous.” This rejection is facially

improper because breadth is not the same as definiteness. *See* MPEP 2173.04 (entitled “Breadth Is Not Indefiniteness”).

In any event, the Final Office Action’s issue with the word “assessed” in the phrase “assessed customer use of the software products” is easily resolved when that phrase is read in its entirety. In so doing, it becomes clear that the data to be retrieved is the “assessed customer use of the software products.” This language means, for example, that customer use of the software products must at some point be “assessed.” Those skilled in the art are capable of determining whether “assessed customer use of the software products” is or is not retrieved. As a result, there is no definiteness issue and there is no problem with the scope of the claim. Applicant declines the Final Office Action’s invitation to artificially and unnecessarily limit the scope of the claim by requiring some non-essential further “assessing” step.

Of course, the removal of the word “assessed” suggested in the Final Office Action would change the meaning of the claim because the retrieval of any data pertaining to “customer use of the software products” presumably would meet the language — rather than just the “assessed” “customer use of the software products.” The Final Office Action’s suggested change therefore would make the claim less, not more, clear. Reconsideration and withdrawal of this § 112 rejection therefore are respectfully requested.

Second, with respect to the introductory recitation of “In a license ownership computer” in the preamble of claim 32, Applicant points out that this phrase merely specifies where the “method of displaying a license ownership position for a vendor’s software products for a customer” is to be performed. Those skilled in the art would understand that the “customer” is not somehow embodied in a computer. Those skilled in the art also would apprehend that “retrieving software product licensing data from a sales database in communication with the

license ownership computer” means just that -- namely, that a database is in communication with the license ownership computer. Again, there is nothing unclear or indefinite about this language when it is read in its entirety. And again, the confusion between claim scope and claim definiteness renders this § 112 rejection facially inappropriate. Reconsideration and withdrawal of this § 112 rejection therefore are respectfully requested.

Third, with respect to the term “further” in claim 32, Applicant notes that this word is not a term of degree at all. Quite the contrary, claim 32 specifies both “retrieving software product licensing data . . .” and “retrieving further software product licensing data. . . .” When these phrases are read together and in context, it is clear that the word “further” simply means that the “software product licensing data” in (ii) is not exactly the same “software product licensing data” in (i). Contrary to the Final Office Action’s assertion, the word “further” makes the claim more clear and more definite. Reconsideration and withdrawal of this § 112 rejection therefore are respectfully requested.

Fourth, with respect to the indication that “the license ownership position is refined by providing further data,” Applicant is unaware of any requirement to the effect that each and every recitation must be tied to a corresponding structural component -- particularly in the context of a method claim. Those skilled in the art are plainly capable of determining whether “the license ownership position” is or is not “refined.” Thus, there is nothing unclear or indefinite about this language. Applicant once again declines the invitation to artificially and unnecessarily limit the scope of the claims and once again notes that breadth is not indefiniteness. Reconsideration and withdrawal of this § 112 rejection therefore are respectfully requested.

Fifth, without acquiescing to the propriety of the rejection of claim 35 related to the term “receiving,” Applicant has amended this claim so as render moot the formalities-based rejection thereof. Reconsideration and withdrawal of the same therefore are respectfully requested.

Sixth, Applicant does not understand the requirement for a separate storing step for “storing assessed customer use of the products into the analysis database.” For example, the assessed customer use of the products into the analysis database may be effectively “pre-stored” in the analysis database, thereby making any further “storing” unnecessary. The Final Office Action’s additional “requirement” therefore seems to be rather optional and instead unnecessarily limiting. Thus, reconsideration and withdrawal of this § 112 rejection therefore are respectfully requested.

Seventh, Applicant notes that claim 32 of the PCT application originally specified “retrieving assessed use of the software products by the customer.” This language was changed (e.g., for clarity) to the current language of “retrieving assessed customer use of the software products.” At least the original language of claim 32, and the Abstract, provide ample support for this recitation of claim 32 (and the analogous recitations in claims 35 and 75). One skilled in the art would recognize from the original wording of claim 32, the Abstract, and elsewhere in the specification, that the inventors were in possession of the “retrieving assessed customer use of the software products” at the time the application was filed. Thus, reconsideration and withdrawal of this § 112 rejection therefore are respectfully requested.

Eighth, Applicant notes that paragraph 234 of the published application indicates that “The display of licence ownership and compliance table method and method for the graphical display of ownership and compliance provide a LOP [License Ownership Position]” which is calculated by a series of algorithms. . . . These algorithms are automatic and based on a set of

rules and assumptions.” At least this paragraph and those that follow provide clear support for “assumptions as defined by prestored algorithms” such that one skilled in the art would recognize that the inventors were in possession of this subject matter at the time the application was filed. Notably, literal, or *in haec verba*, support is not the test for compliance with the written description requirement. Thus, reconsideration and withdrawal of this § 112 rejection therefore are respectfully requested.

Ninth, claims 75-77 are not hybrid system/method claims at all. Claim 75 clearly is directed to a license ownership computer system that is configured to perform specifically enumerated functions. Claim 75 is not a method claim at all. Claim 76 is directed to “non-transitory computer readable media.” Claim 76 is not directed to either a system or method. Rather, when read carefully, it becomes clear that the software stored on the non-transitory computer readable media when executed performs a particular method. This sort of claim is entirely appropriate and plainly is not directed to both a system and a method. Finally, claim 77 has been cancelled without prejudice or disclaimer, thereby rendering moot this portion of the rejection. Thus, reconsideration and withdrawal of this § 112 rejection therefore are respectfully requested.

In view of the foregoing, it is believed that all of the § 112 rejections have been addressed and overcome. Reconsideration and withdrawal of the same are respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 32-35, 37-39, and 75-77 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Peterson et al. (U.S. Patent No. 7,197,466), and claim 36 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Peterson in view of Applicant’s

Admitted Prior Art (AAPA). These rejections are respectfully traversed for at least the following reasons.

Claims 32 and 75 specify that, *inter alia*, “the license ownership position is refined by providing further data.” This feature is not taught or suggested by the cited art, alone or as allegedly modified. Thus, the rejection of these claims (and their dependents) is improper.

The Final Office Action concedes that Peterson does not disclose the above-quoted subject matter but nonetheless asserts that “it is [a] predictable result that an ordinary practitioner in an operation of data analysis will strive to use further data in modeling to achieve more reliable results to better represent the current scenario.” Of course, the Final Office Action provides no support whatsoever for this assertion. For example, the Final Office Action does not even attempt to show what data would be used or how such data could be used. Moreover, there is a logical gap between wanting to build a model with “further data” and the claim language of refining the license ownership position by providing the further data. As the Board has repeatedly cautioned, the legal conclusion of obviousness cannot be support without a clearly articulated underlying factual basis. Here, there is absolutely no factual basis beyond the Final Office Action’s bare assertion. And of course the MPEP is quite clear that just because a modification could have been made does not necessarily meant that it would have been obvious to one of ordinary skill in the art at the time of the invention to have made that particular modification.

Perhaps recognizing this flaw, the Final Office Action erroneously contends that the above-quoted claim language is a statement of “the intended result of the positively recited steps in the claims and fails to define the steps or acts to be performed in the method claims or the discrete physical structure required of system claims, and thus has no patentable weight.” But

this assertion apparently misses the point that preceding the claim recitations do not involve any refining -- much less a situation in which the license ownership position is refined by providing further data. The refining-related recitation thus is a further part of the claims and not a mere intended result. The fact that it is phrased as a part of a “wherein” clause does not mean that it can simply be ignored. Rather, as explained in the MPEP, all claim limitations must be considered. This is especially true in the context of the method claims.

In sum, there is no reasonable basis for trivializing or completely ignoring the above-quoted feature of the independent claims -- which admittedly is missing from the cited art. The further introduction of the AAPA does not make up for this feature. Thus, reconsideration and withdrawal of the § 103 rejections are respectfully requested.

In addition to the above, claim 32 now calls for “calculating a license ownership position based on analysis of the retrieved software product licensing data, further software product licensing data and assessed customer use.” This further subject matter is absent from the cited art, and the allegedly obvious modification thereto. This is a further flaw with the rejection of claim 32 and its dependents.

New Claim 78

New claim 78 requires a similar feature to that discussed above with respect to claim 32. New claim 78 should be allowable at least by virtue of its dependence on claim 75, as well as the recitation of this further subject matter.

Conclusion

In view of the above amendments and remarks, Applicants respectfully submit that all the claims are patentable and that the entire application is in condition for allowance. Should the

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Examiner believe that anything further is desirable to place the application in better condition for allowance, he is invited to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140 under Order No. PTB-4942-6.

Respectfully submitted,

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